

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| |) | Confirmation No.: 2257 |
| Applicants: LOWERY |) | |
| |) | Group Art Unit: 3622 |
| Application No.: 10/061,129 |) | |
| |) | Examiner: Retta, Yehdega |
| Filing Date: November 13, 2001 |) | |
| |) | Attorney Docket No.: G04.014 |
| For: METHOD AND APPARATUS FOR |) | PTO Customer Number 67338 |
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Commissioner for Patents
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Sir:

Applicants submit the following **Reasons** in support of the Pre-Appeal Brief Request For Review filed herewith:

The **Reasons** begin on page 1 below.

REASONS

The following is evidence of clear error in the rejection of independent claims 1 and 60.

Claim 1

Independent claim 1 recites a method for facilitating multiparty communication regarding leads, comprising: receiving initial information regarding a customer lead from a first party, wherein the initial information identifies a service and the first party is a referral source **other than said customer; after receiving the initial information**, identifying a second party that can provide the service and to which to provide at least a portion of the initial information; providing at least a portion of said initial information to said second party; receiving updated information regarding said customer lead from said second party; and determining compensation owed by said second party based, at least in part, on said updated information; and wherein the updated information includes at least one of the following: a postal address for the customer; and a telephone number for the customer. (emphasis added).

Neither powerbuyerservice.com, nor Joao, nor any proper combination of powerbuyerservice.com, Joao and Official Notice in the Office Action teaches or suggests the method recited in claim 1.

The Web site provided at www.powerbuyerservice.com allows **a customer** to select one or more service providers that the customer is interested in learning about and then informs the relevant service providers of the customer's interest (Applicant's application, page 1, lines 20-23). (emphasis added).

However, as admitted in the Office Action, powerbuyerservice.com does not teach or suggest receiving initial information regarding a customer lead from a first party, wherein the initial information identifies a service and the first party is a referral source **other than said customer**, as recited in claim 1. (emphasis added).

Moreover, powerbuyerservice.com does not appear to teach or suggest the recitation **"after receiving the initial information**, identifying a second party that can provide the service and to which to provide at least a portion of the initial information", as recited in claim 1. (emphasis added).

Joao discloses an apparatus and method for effectuating an affiliated marketing relationship (title).

However, Joao does not teach or suggest the combination of receiving initial information regarding a customer lead from a first party, wherein the initial information identifies a service and the first party is a referral source **other than said customer**; and **after receiving the initial information**, identifying a second party that can provide the service and to which to provide at least a portion of the initial information, as recited in claim 1. (emphasis added).

The Final Office Action states that the powerbuyerservice website does not exclude anyone from entering user information that might need service, and further states that the web site is therefore equipped to receive information from anyone who wants to enter the information.

The Final Office Action (and the Advisory Action) further state that Applicant and Joao disclose that companies use telemarketers, call centers, marketing agents etc. to generate leads for the company, and that therefore, it would have been obvious to one of ordinary skill in the art to receive the customer information from a referral source, such as telemarketers, call centers or marketing agents.

Applicant respectfully disagrees.

First, Applicant respectfully requests that the Examiner provide support for the assertion that that the powerbuyerservice.com website does not exclude anyone from entering user information that might need service, and that the web site is therefore equipped to receive information from anyone who wants to enter the information. Applicant respectfully points out that powerbuyersource.com states that we make it very easy for you to use our program. Simply register your company and our preferred providers can all be accessed through one point of contact - our 800#. We look forward to the opportunity to work with you. (powerbuyerservice, benefits page, fourth bulleted paragraph, middle of benefits page).

Second, the mere statement that a company may use telemarketers, call centers, marketing agents etc. to generate leads for the company cannot possibly stand for a universally applicable principle that would lead one skilled in the art to modify every company or program to use telemarketers, call centers, marketing agents etc. to generate leads.

For example, powerbuyerservice.com is already a referral source.

The mere statement that a company may use telemarketers, call centers, marketing agents etc. to generate leads for the company does not teach or suggest modifying a referral service

such as powerbuyerservice.com to use another referral service to generate leads for other companies.

Moreover, power buyer.com service is a referral service that is **intended to operate via contact made by the customer**.

Modifying powerbuyerservice.com to use telemarketers, call centers, marketing agents etc. to generate leads would mean that the telemarketers, call centers, marketing agents etc. make contact with the customer, rather than allowing the customer to make the contact with powerbuyerservice.com, thereby changing and defeating the operating principle of powerbuyerservice.com.

Thus, the combination proposed by the Office Action fails to meet the requirements of MPEP 2143.021(IV), which states that **the proposed modification cannot change the principle of operation of a reference**. (emphasis added). Indeed, MPEP 2143.01(IV) further states that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are **not sufficient to render the claims prima facie obvious**. (emphasis added).

Consequently, Applicant respectfully submits that the combination is improper and cannot possibly establish a prima facie case of unpatentability.

Further, powerbuyerservice.com states that the power buyer preferred providers are number one, two or three in their industries and that such providers provide top quality products and service (powerbuyerservice, benefits page, second bulleted paragraph, middle of benefits page).

The mere statement that a company may use telemarketers, call centers, marketing agents etc. does not teach or suggest that the preferred providers of powerbuyerservice.com would permit use of telemarketers, call centers, marketing agents etc. to generate leads. Moreover, even if one of such providers had a desire to use telemarketers, call centers, marketing agents etc. to generate lead which Applicant does not admit, there is no teaching or suggestion that it would be done through powerbuyerservice.com.

For at least the reasons above, Applicant respectfully submits that the combination is improper and cannot possibly establish a prima facie case of unpatentability.

Furthermore, and as stated above, powerbuyerservice.com, does not teach or suggest the recitation "**after receiving the initial information**", identifying a second party that can provide

the service and to which to provide at least a portion of the initial information", as recited in claim 1 (emphasis added).

Consequently, even if powerbuyerservice.com was modified to use a telemarketer to generate leads for a company, which Applicants do not admit is obvious, the modified powerbuyerservice.com would still not teach or suggest the recitation "**after receiving the initial information**, identifying a second party that can provide the service and to which to provide at least a portion of the initial information", as recited in claim 1. (emphasis added).

The rejection is therefore improper and cannot possibly establish a prima facie case of unpatentability.

Still further, Applicant respectfully points out that the Office Action does not articulate how powerbuyerservice.com could possibly teach the recitation "**after receiving the initial information**, identifying a second party that can provide the service and to which to provide at least a portion of the initial information", as recited in claim 1. (emphasis added).

Rather, the Office Action appears to merely assume that it does.

Consequently, Applicant respectfully submits that the rejection is also unclear and thus cannot possibly establish a prima facie case of unpatentability.

Applicant respectfully submits that Applicant should not be required to guess what is in the mind of the Examiner. As stated in MPEP 706, "the goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Applicants respectfully submit that the rejection falls short of the goal set forth in MPEP 706.

In addition, if the position of the Examiner is that the recitation "**after receiving the initial information**, identifying a second party that can provide the service and to which to provide at least a portion of the initial information", is inherent in powerbuyerservice.com, Applicant respectfully disagrees.

As stated in MPEP 2112 (IV) " 'to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present' . . . [i]nherency . . . may not be established by probabilities or possibilities' ", citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added).

Applicant respectfully submits that the evidence does not make it clear that the recitation "**after receiving the initial information**, identifying a second party that can provide the service

and to which to provide at least a portion of the initial information", is inherent in powerbuyerservice.com.

For example, Applicant respectfully notes that Applicant's background states that powerbuyerservice.com allows **a customer** to select one or more service providers that the customer is interested in learning about and then informs the relevant service providers of the customer's interest. (emphasis added).

For at least the reasons above, Applicant respectfully submits that the rejection is improper and unclear and cannot possibly establish a prima facie case of unpatentability.

Claim 60

Independent claim 60 also recites a method for facilitating multiparty communication regarding leads, comprising: receiving initial information regarding a customer lead from a first party, wherein the initial information identifies a service and the first party is a referral source **other than said customer**; and **after receiving the initial information**, identifying a second party that can provide the service and to which to provide at least a portion of the initial information. (emphasis added).

Consequently, and for at least the reasons set forth above with respect to claim 1, neither powerbuyerservice.com, nor Joao, nor any proper combination thereof in the Office Action or Advisory Action teaches or suggests the method recited in claim 60.

Reconsideration and allowance of the present application are respectfully requested.

Respectfully submitted,

November 10, 2008
Date

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